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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,144	12/17/1999	Jaya Shankar Pathmasuntharan	004404.P002	9823

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EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/466,144

Applicant(s)

PATHMASUNTHARAN ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-12,60-69 and 90-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-12,60-69 and 90-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 06 May 2004.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Asami (US 6,036,100).

Re claims 1-3 and 7-9: Asami discloses a smart card 1 comprising: an interface 3 with a smart card reader 12; a first circuitry 5 configured to receive a first enable signal (b) from a host computer 2, which serves as a portable smart card enabler device; and second circuitry 8 coupled

with the interface 3 and the first circuitry 5 and configured to allow the smart card 1 to function with the smart card reader 12 upon receiving the first enable signal (b) from the portable smart card enabler device 2 by the first circuitry 3 (figs. 1 and 2; col. 3, line 27 through col. 4, line 67) and to disable the smart card 1 to function with the smart card reader 12 if the first circuitry does not receive the first enable signal (b) from the portable smart card enabler device (fig. 3; col. 5, lines 23+); wherein the first circuitry 5 is also configured to receive a second enable signal (c) from the portable smart card enabler device (fig. 2; col. 4, lines 55+), and wherein the second circuitry 8 is also configured to allow the smart card 1 to perform a transaction (e.g., processing the received data) with the smart card reader 12 upon receiving the second enable signal (c) from the portable smart card enabler device by the first circuitry 5 and to disable the smart card 1 to perform the transaction with the smart card reader 12 if the first circuitry 5 does not receive the second enable signal from the portable smart card enabler device (fig. 3; col. 5, lines 23+); wherein the first enable signal and the second enable signal are radio frequency signals (col. 4, lines 27+ and lines 48+); wherein the second circuitry 8 performs the transaction with the smart card reader through the interface after receiving the first enable (b) signal and the second enable (c) signal from the portable smart card enabler device; wherein the second circuitry 8 performs the transaction for the smart card that is within a close proximity of the smart card enabler; wherein the second circuitry 8 includes a memory 7 storing first identification key and a first transaction key; and a central processing unit coupled to the memory and configured to send the first identification key and first transaction key to the portable smart card enabler device, and wherein the first enable signal (b) and the second enable signal (c) are received from the portable smart card enabler device based on the first identification key and first transaction key (see figs. 1 and 6; col. 8, line 28 through col. 9, line 35).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asami in view of Schick et al (US 5,180,902). The teachings of Asami have been discussed above.

Re claim 6, Asami fails to teach or fairly suggest that the smart card is disabled to perform the transaction after a predetermined time period.

Schick et al teaches the card is disabled within a specific time period (col. 2, lines 60+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schick et al into the teachings of Asami in order to provide Asami with a more secure system to prevent the identification number/password being manipulated by an unauthorized user/operator.

7. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asami in view of Naruse et al (US 4,973,828). The teachings of Asami have been discussed above.

Re claims 10-12, Asami has been discussed above but fails to teach or fairly suggest that the memory also stores a first transaction value, the first transaction value representing an available amount of hard currency in electronic form for the smart card, wherein the central processing unit is also configured to generate a second transaction value as a result of a transaction and replace the first transaction value with the second transaction value.

Naruse et al teaches a memory 32 storing each transaction including value, date and time; the memory 32 also update the maximum amount allowed for transaction in each effective term of transactions (figs. 2 and 3; col. 3, lines 1-32).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Naruse et al into the smart card system as taught by Asami in order to provide Asami with a versatile system, in which the card is applied for use in a financial transaction system. Furthermore, such modification would provide Asami with an organized system wherein the history of transactions are recorded and can be retrieved readily, and providing a secure system with a capability of preventing a user from spending over limit by updating maximum amounts regularly.

8. Claims 60-69 and 90-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asami in view of Kawan et al (EP 0,949,593) and Naruse et al. The teachings of Asami as modified by Naruse et al have been discussed above.

Re claims 60-69 and 90-96: Asami have been discussed above but fail to teach or fairly suggest that the smart card comprising a second interface, wherein the second interface comprises a contact interface.

Kawan et al teaches a smart card 12 having a contact interface 14 and a contactless interface 16 (fig. 1; abstract, lines 3+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kawan et al into the smart card system as taught by Asami in order to provide Asami with a versatile system wherein the card can be used in either contact or contactless mode. Furthermore, such modification would provide Asami with a capability of transmitting the transaction data that has been interacted with the card reader to the host computer for later use.

Asami as modified by Kawan et al fails to teach or fairly suggest that the smart card comprising an I/O interface coupled to the processing unit, wherein the I/O interface comprises a key pad, a display; the memory also stores a first transaction value, the first transaction value representing an available amount of hard currency in electronic form for the smart card, wherein the central processing unit is also configured to generate a second transaction value as a result of a transaction and replace the first transaction value with the second transaction value.

Naruse et al teaches a memory 32 storing each transaction including value, date and time; the memory 32 also update the maximum amount allowed for transaction in each effective term of transactions (figs. 2 and 3; col. 3, lines 1-32).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Naruse et al into the smart card system as taught by Asami in order to provide Asami with a versatile system, in which the card is applied for use in a financial transaction system. Furthermore, such modification would provide Asami with an organized system wherein the history of transactions are recorded and can be retrieved readily, and providing

a secure system with a capability of preventing a user from spending over limit by updating maximum amounts periodically.

### *Response to Arguments*

9. Applicant's arguments with respect to claims 1 and 60 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited references to Asami, Kawan et al and Naruse et al were used in the new ground of rejection to further meet the newly added limitation of claims 1, 60 and 90.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Rozin et al (US 5,847,447); Davis et al (US 5,577,121); Horne et al (US 6,247,644); Wallerstein (US 5,955,961); Fujioka (US 5,727,230); Katayama et al (US 5,418,353); Fujioka (US 5,896,325) are cited as of interest and illustrate to a similar structure of a system and method for using a smart card.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the



date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon, Wed. and Fri. 5:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Uyen-Chau N. Le  
July 28, 2004

  
**THIEN M. LE**  
**PRIMARY EXAMINER**